

Applicant : Khosravi, et al.
Appl. No. : 09/427,260
Examiner : B. Pellegrino
Docket No. : 702563.4004

Remarks

Claims 29-30 and 55-62 are pending. New claims 59-62 have been added by the present amendment. Claim 58 was originally added by way of an amendment filed on May 10, 2001. Although the claim was never withdrawn or cancelled, it was not rejected, objected to, or allowed in the office action mailed on November 4, 2002, or the present office action mailed May 16, 2003.

Applicant respectfully requests consideration of the application and claims in view of the following remarks.

Objection to Drawings

The Examiner objected to the drawings under 37 C.F.R. 1.83(a), for failing to show every feature of the claimed invention. The Examiner stated that the drawings must show every feature of the invention specified in the claims, and that, therefore, "the embodiment of a stent with a coiled sheet of expandable wing-like elements having a plurality of locking elements must be shown or the feature(s) canceled from the claim(s)."

Applicant maintains that its response to this objection stated in its previously filed amendment was proper, and that such embodiment is fully shown in the drawings in full compliance with section 1.83(a). For example, Figures 1A and 1B show a coiled-sheet stent 10 having, *inter alia*, "a plurality of stretchable elements 30 formed therein," (Spec., pg. 14, ll. 3-4), and having a first edge 20 "having a plurality of fingers or teeth 24 extending therefrom," (Spec. pg. 13, l. 21 to pg. 14, l. 1). As the specification further states: "The stretchable elements included in the coiled-sheet stents may take on a number of different forms." (Spec., pg. 22, ll. 21-22). Several of the forms of these stretchable elements are

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shown in the figures, including the "wing-like elements" shown in Figures 9, 10A, and 10B, (See Spec., pg. 28, l. 6 to pg. 29, l. 8). Thus, as required by section 1.83(a), the figures "show every feature of the invention specified in the claims," and the specification states that the features may be combined in alternative embodiments.

Nevertheless, in order to expedite prosecution of the present application, Applicant has complied with the Examiner's objection and amended Figure 9 on the replacement drawing sheet attached hereto at Tab A to show a plurality of locking elements (24), as recited in claims 29, 56, and 60, and as described in the specification as set forth above. Applicant submits that this amendment is in compliance with the Examiner's objection, and that no new matter is added thereby.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, the Examiner maintained rejections of claims 29 and 30 over U.S. Patent No. 5,800,520 ("the Fogarty et al. patent" or "the '520 patent") in view of U.S. Patent No. 5,441,515 ("the Khosravi et al. patent" or "the '515 patent") and U.S. Patent No. 5,895,406 ("the Gray et al. patent" or "the '406 patent"). The Examiner also maintained rejections of claims 55 through 57 over the Fogarty et al. patent in view of the Gray et al. patent. In his response to Applicant's arguments filed on March 4, 2003, the Examiner stated his recognition that obviousness can be established by combining or modifying the teachings of the prior art only where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner stated that, in this case: "Fogarty was

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interested in flexibility and to use the Gray teaching would have been obvious because the end product is to have a flexible stent.”

Applicant respectfully requests reconsideration of these rejections for the following reasons. First, Fogarty’s “interest” in flexibility is an inadequate basis upon which to conclude that a person of ordinary skill in the art would have been motivated to combine the teachings of the Fogarty and Gray patents. The Fogarty et al. patent refers to “flex” or “flexibility” in only two instances, at col. 5, line 51 and at col. 9, line 8. The first instance states only that the longitudinal axis of the stent will curve or flex. The second states that flexibility of the stent is enhanced by providing only two bridge elements (13) between pairs of band member (11). In no way do either of these references teach or suggest that, for example, stent flexibility is a particular problem, or that it is a problem that should be solved by providing stretchable wing-like elements extending generally parallel to the longitudinal axis of the stent. There is simply no teaching in the Fogarty et al. patent that would lead a person of ordinary skill in the art to combine its teachings with those of the Gray et al. patent.

Second, the Examiner’s response does not address Applicant’s previous arguments establishing that there is no suggestion to combine the Fogarty et al. patent, Gray et al. patent, and the Khosravi et al. patent. In addition to the lack of suggestion or teaching to combine Fogarty and Gray discussed above, the Khosravi patent is even further removed in that it does not teach or suggest a mesh pattern having an unstretched or peripherally contracted condition when the stent is in a contracted condition, and a stretched or peripherally expanded condition to facilitate expansion of the coiled-up sheet to one or more enlarged conditions. Nowhere is there a suggestion or teaching that would motivate

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one of ordinary skill in the art to combine these three disparate disclosures in the manner that the Examiner has chosen to do.

The mere fact that several of the elements of Applicant's claims may be found in the three cited references is simply not enough to support a *prima facie* case of obviousness. See In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998). Indeed, the only support for making the combination is to use Applicant's claims as a template, which is improper. Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570 (Fed. Cir. 1996). For these reasons, Applicant respectfully requests reconsideration of the rejections made in the present Office Action, and allowance of claims 29-30 and 55-58.

New Claims 59 through 62

New claims 59 through 62 recite several of the features contained in claims 29 and/or 55, and are patentable over any proposed combination of Fogarty, Gray, and Khosravi for the reasons set forth above.

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CONCLUSION

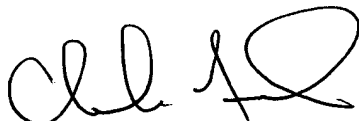
In view of the foregoing, it is submitted that the claims now presented in this application define patentable subject matter over the cited prior art. Accordingly, reconsideration and allowance of the application is requested.

Respectfully submitted,

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Dated: November 17, 2003

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